# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/896,838 | 06/29/2001 | Dwight Marcus | 0008016-0002 | 5872 |

| 24201 | 7590 | 03/14/2006 |
|---|---|---|

FULWIDER PATTON
6060 CENTER DRIVE
10TH FLOOR
LOS ANGELES, CA 90045

| EXAMINER |
|---|
| BEKERMAN, MICHAEL |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3622 | |

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 09/896,838 | MARCUS, DWIGHT |
| | Examiner | Art Unit |
| | Michael Bekerman | 3622 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL**.    2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) *1-147* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-147* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

## Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on *1/16/2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *9/30/2004*.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

## DETAILED ACTION

### *Specification*

1.    The disclosure is objected to because of the following informalities: On page 29,

Lines 4-5 contain blanks for filling out information regarding a co-pending Provisional

Patent Application.  This information needs to be completed.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

2.    The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3.    **Claims 17-20, 36, 40-43, 66-69, 85, 89-92, and 99-147 are rejected under 35**

**U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.**

The claim(s) contains subject matter which was not described in the specification in

such a way as to enable one skilled in the art to which it pertains, or with which it is

most nearly connected, to make and/or use the invention.

**Regarding claims 17-20, 66-69, and 115-118**, these claims depend from claims

12, 61, and 110 respectively.  The parent claims recite the limitation of a conversion

code that is used to convert signifiers into desired information.  Claims 17, 66, and 115

recite the limitation that the desired information is directly revealed.  The other claims

recite the limitations of scratch-off, peel-off, or add-on patterns as revealing the desired

information and it is unclear as to how this can be done in conjunction with a conversion

code.

**Regarding claims 36, 40-43, 85, 89-92, 134 and 138-141**, the specification

does not contain enabling disclosure for the terms "first layer" and "underprinting" for the

context in which they are used in the claims. There is no disclosure for how to move or

remove underprinting, and there is no disclosure describing to which layer a "first layer"

refers or how to move or remove that first layer. Examiner considers "first layer",

"underprinting", and "printing" to refer to the same thing.

**Regarding claims 99-147** in general, these claims refer to computer readable

code configured to perform the steps described by the earlier method claims. The

specification does not contain enabling disclosure for how computer readable code

would be able to perform such steps. Examiner will list some **(but not all)** examples of

this:

> Claim 99 – How can computer readable code be configured to provide or
>
> deliver an incentive?
>
> Claim 110 – How can computer readable code be configured to convert
>
> signifiers using a conversion code?
>
> Claims 116-118 – How can scratch-off, peel-off, or add-on patterns be
>
> implemented within computer readable code?
>
> Claims 127-128 – How does computer readable code insert signifiers into
>
> a wall of a structure or on the field of a ball park?

Claim 130 – How does computer readable code associate partitions with a

unitary product?

Claim 135 – How does computer readable code manipulate layers?

While these are only 6 examples, applicant is advised to address all 112 1st paragraph

issues regarding the same questionable subject matter, **including those not explicitly**

**listed here.**

4.      The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

5.      **Claims 17-20, 26, 36, 40-43, 66-69, 75, 85, 89-92, and 99-147 are rejected**

**under 35 U.S.C. 112, second paragraph, as being indefinite for failing to**

**particularly point out and distinctly claim the subject matter which applicant**

**regards as the invention.**

**Regarding claims 17-20, 66-69, and 115-118**, it is unclear as to how desired

information is directly revealed or revealed by scratch-off, peel-off, or add-on patterns

since these claims depend from claims that specifically say the desired information is

converted from signifiers using a conversion code.

**Regarding claims 26, 75, and 124**, these claims recite the limitation "improved

customer support". It is unclear as to what the customer support it to be improved over,

or to what degree it has been improved.

**Regarding claims 36, 40-43, 85, 89-92, 134 and 138-141**, it is unclear as to

exactly what "first layer" and "underprinting" refer. It is also unclear as to how a "first

layer" or "underprinting" is to be moved or removed. In the interest of applying art, Examiner considers "first layer", "underprinting", and "printing" to all refer to the same thing.

**Regarding claims 99-147** in general, these claims refer to computer readable code configured to perform the steps described by the earlier method claims. It is unclear as to how computer readable code would be able to perform such steps. Examiner will list some **(but not all)** examples of this:

> Claim 99 – How can computer readable code be configured to provide or deliver an incentive?

> Claim 110 – How can computer readable code be configured to convert signifiers using a conversion code?

> Claims 116-118 – How can scratch-off, peel-off, or add-on patterns be implemented within computer readable code?

> Claims 127-128 – How does computer readable code insert signifiers into a wall of a structure or on the field of a ball park?

> Claim 130 – How does computer readable code associate partitions with a unitary product?

> Claim 135 – How does computer readable code manipulate layers?

While these are only 6 examples, applicant is advised to address all 112 2nd paragraph issues regarding the same questionable subject matter, **including those not explicitly listed here.**

### *Claim Rejections - 35 USC § 102*

6.      The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7.      **Claims 1-6, 11, 27, 47-55, 60, 76, 96-104, 109, 125, and 145-147 are rejected**

**under 35 U.S.C. 102(b) as being anticipated by Von Kohorn (U.S. Patent No.**

**5,034,807).** Von Kohorn teaches the verification of review of information that includes

all of the limitations recited in the above claims.

        **Regarding claims 1-3, 50-52, and 99-101**, Von Kohorn teaches the providing of

a coupon (Column 9, Lines 43-45) for reviewing an electronic broadcast and the

answering of questions about specific parts (signifiers) of that broadcast (Column 2,

Lines 19-39).  Coupons provide discounts for products and services.

        **Regarding claims 4, 5, 53, 54, 102, and 103**, Von Kohorn teaches a scoring

system that checks to see if the user's score is within an acceptable range (threshold

value) for receiving a prize (Column 37, Lines 62-67 and Column 38, Lines 1-4).

        **Regarding claims 6, 11, 55, 60, 104, and 109**, Von Kohorn teaches telephone

and written response as old and well-known forms of communication (Column 1, Lines

45-49).

     **Regarding claims 27, 76, and 125**, Von Kohorn teaches a redeemable coupon as being the incentive (Column 9, Lines 43-45). A redeemable coupon is a provided information that contains signifiers (discount information, merchandise information, etc...).

     **Regarding claims 47-49, 96-98, and 145-147**, Von Kohorn teaches questions being sent along with a broadcast program. Once the viewer answers the questions (detects the signifiers) (Column 2, Lines 19-39), the scoring is handled by a sufficiency determiner that determines whether the answers (detected signifiers) are sufficient to earn an incentive (Column 37, Lines 62-67 and Column 38, Lines 1-4). When the user submits answers, this meets the step of detecting a physical presence. When the user reads electronically presented questions, that satisfies the step of electronic detection.


8.     **Claims 1, 7, 12, 13, 46, 50, 56, 61, 62, 95, 99, 105, 110, 111, and 144 are rejected under 35 U.S.C. 102(e) as being anticipated by Gropper (U.S. Patent No. 6,883,000).** Gropper teaches a contact management system that includes all of the limitations recited in the above claims.

     **Regarding claims 1, 50, and 99**, Gropper teaches inserting one or more signifiers (business information) into a provided information (business card), and delivering an incentive (user obtains contact information) when the business card is reviewed (Abstract).

     **Regarding claims 7, 56, and 105**, Gropper teaches connection to a website as being an old and well-known form of communication (Abstract).

**Regarding claims 12, 13, 46, 61, 62, 95, 110, 111, and 144**, Gropper teaches

putting a conversion code (the UCL) on the business card that, once used, will provide

the user with further contact information (Column 11, Lines 56-59, and Abstract).

Contact information will inherently encode regional information.

9.      **Claims 1, 12, 14-18, 33-43, 50, 61, 63-67, and 82-92 are rejected under 35**

**U.S.C. 102(b) as being anticipated by Halladay (U.S. Patent No. 4,850,618).**

Halladay teaches a lottery ticket that includes all of the limitations recited in the above

claims.

**Regarding claims 1, 16, 50, and 65**, Halladay teaches inserting signifiers

(scratch-off layer) on a lottery ticket (provided information, game card).  If the user

displays knowledge of how to scratch off the layer, they receive an incentive (ability to

be entered into the lottery game) (Abstract).

**Regarding claims 12, 14, 15, 17, 18, 61, 63, 64, 66, and 67**, Halladay teaches a

conversion code (act of scratching off the layer) to convert a signifier (scratch off layer)

into desired information (lottery number) (Abstract).

**Regarding claims 33-43 and 82-92**, Halladay teaches a lottery ticket (recording

card) that has more than one layer with printed information, and in which printed layers

are manipulated by being removed (or moved from the card).

10.    **Claims 1, 12, 16, 19, 50, 61, 65, and 68 are rejected under 35 U.S.C. 102(b) as being anticipated by D'Amato (U.S. Patent No. 3,900,219).** D'Amato teaches a lottery ticket that includes all of the limitations recited in the above claims.

**Regarding claims 1, 16, 50, and 65**, D'Amato teaches inserting signifiers (peel-off layer) on a lottery ticket (provided information, game card). If the user displays knowledge of how to peel off the layer, they receive an incentive (ability to be entered into the lottery game) (Abstract).

**Regarding claims 12, 19, 61, and 68**, D'Amato teaches a conversion code (act of peeling off the layer) to convert a signifier (peel off layer) into desired information (lottery number) (Abstract).


11.    **Claims 1, 12, 16, 20, 21, 50, 61, 65, 69, and 70 are rejected under 35 U.S.C. 102(b) as being anticipated by Shneifer (U.S. Patent No. 5,580,054).** Shneifer teaches a lottery ticket that includes all of the limitations recited in the above claims.

**Regarding claims 1, 16, 50, and 65**, Shneifer teaches inserting signifiers (detachable portions) on multiple lottery tickets (provided information, game cards). If the user displays knowledge of how to detach and add-on the portions, they receive an incentive (ability to be entered into the lottery game) (Abstract).

**Regarding claims 12, 20, 61, and 69**, Schneifer teaches a conversion code (act of detaching and attaching the portions) to convert a signifier (attachable/detachable portions) into desired information (completed winning image) (Abstract).

**Regarding claims 21 and 70**, the game pieces are divided into partitions that the user must assemble.

12. **Claims 1, 22-26, 50, and 71-75 are rejected under 35 U.S.C. 102(b) as being anticipated by Voltmann (U.S. Design Patent No. 264,810).** Voltmann teaches a medicine container that includes all of the limitations recited in the above claims.

**Regarding claims 1, 22-26, 50, and 71-75**, Voltmann teaches signifiers (name, time, etc...) inserted into provided information (medical instructions) (Shown on the lid in Figure 1). After review of the instructional information, the user receives an incentive (ability to use the product, support for the customer's use of that product is also improved).

13. **Claims 1, 28-30, 50, 77-79, 99, and 126-128 rejected under 35 U.S.C. 102(e) as being anticipated by Bernard (U.S. Patent No. 6,293,868).** Bernard teaches a stadium game displayed on a scoreboard that includes all of the limitations recited in the above claims.

**Regarding claims 1, 28-30, 50, 77-79, 99, and 126-128**, Bernard teaches providing information at an event, on the wall of a structure, and on the field of a ball park (information on the scoreboard). Those people playing the game taught by Bernard will have their scores (signifiers) displayed on the scoreboard during the event (Column 3, Lines 1-7). If people playing the game pay attention to the scoreboard, they earn an incentive (knowing their score and how close they are to winning).

14.     **Claims 1, 33, 44, 45, 50, 82, 93, 94, 142, and 143 are rejected under 35**

**U.S.C. 102(b) as being anticipated by deBruin.**  deBruin teaches a removable coupon

on product packaging that includes all of the limitations recited in the above claims.

**Regarding claims 1, 33, 44, 45, 50, 82, 93, 94, 142, and 143**, deBruin teaches a

provided information (coupon) inherently containing signifiers (discount amount) and an

incentive is given (discount) if the user reads the coupon and understands the signifier

and how to use it (redeems it).  The coupon is a recording card.  The coupon is located

on the packaging of a bottle of soap (Figures 3 and 4).


15.     **Claims 99, 110, 112-116, and 131-141 are rejected under 35 U.S.C. 102(e) as**

**being anticipated by Auxier (U.S. Patent No. 6,379,251).**  Auxier teaches an internet

scratch-off game that includes all of the limitations recited in the above claims.

**Regarding claims 99 and 114**, Auxier teaches inserting signifiers (virtual

scratch-off layer) on a virtual scratch-off ticket (provided information, virtual game card).

If the user displays knowledge of how to scratch off the layer, they receive an incentive

(ability to be entered into the scratch-off game) (Abstract).

**Regarding claims 110, 112, 113, 115, and 116**, Auxier teaches a conversion

code (act of scratching off the layer) to convert a signifier (virtual scratch off layer) into

desired information (winning number) (Abstract).

**Regarding claims 131-141**, Halladay teaches a lottery ticket (virtual recording

card) that has more than one layer with printed information, and in which virtual printed

layers are manipulated by being removed (or moved from the card).

### Claim Rejections - 35 USC § 103

16.     The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

17.     **Claims 8-10, 57-59, and 106-108 are rejected under 35 U.S.C. 103(a) as**

**being unpatentable over Von Kohorn (U.S. Patent No. 5,034,807).**

**Regarding claims 8-10, 57-59, and 106-108**, Von Kohorn teaches the use of

telephone and written response as means for correspondence (Column 1, Lines 45-49).

Von Kohorn doesn't specify other ways of communication.  Official notice is taken that

e-mail, postal mailing, and facsimile are all old and well-known ways of correspondence.

Any of them could be used by users wanting to submit an indication of knowledge.  It

would have been obvious to one having ordinary skill in the art at the time the invention

was made to use any kind of well-known medium to communicate knowledge.  This

would let users submit their knowledge by whatever means is easiest for them.

18.     **Claims 31, 80, and 129 are rejected under 35 U.S.C. 103(a) as being**

**unpatentable over Bernard (U.S. Patent No. 6,293,868).**

**Regarding claims 31, 80, and 129**, Bernard teaches showing provided information and signifiers on a scoreboard at an event. Bernard doesn't specify video images of said event. Official notice is taken that it is old and well-known for scoreboards to show video of an event. It would have been obvious to one having ordinary skill in the art at the time the invention was made for the scoreboard of Bernard to also show video replays. This would allow people in the audience to better know what is going on.

19.     **Claims 32 and 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shneifer (U.S. Patent No. 5,580,054).**

**Regarding claims 32 and 81**, Shneifer teaches the partitioning of provided information and associating each partition with a lottery card. Shneifer doesn't specify selling the lottery cards together. Official notice is taken that it is old and well-known to package multiple items together to be sold as one unit. This is the same as buying a 6-pack of sodas instead of an individual soda. It would have been obvious to one having ordinary skill in the art at the time the invention was made to sell multiple lottery cards in sets. This would give users a greater chance of winning while more cards could be sold.

20.     **Claim 117 is rejected under 35 U.S.C. 103(a) as being unpatentable over D'Amato (U.S. Patent No. 3,900,219) in view of Auxier (U.S. Patent No. 6,379,251).**

**Regarding claim 117**, D'Amato doesn't teach a virtual computerized peel-off card. Auxier teaches virtual scratch-off game (Abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the peel-off game of D'Amato a virtual computerized game. This would save money.

21.    **Claims 118, 119, and 130 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shneifer (U.S. Patent No. 5,580,054) in view of Auxier (U.S. Patent No. 6,379,251).**

**Regarding claims 118, 119, and 130**, Shneifer doesn't teach a virtual computerized add-on game. Auxier teaches virtual scratch-off game (Abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the add-on game of Shneifer a virtual computerized game. This would save money. Claim 130 can be rejected similarly to claims 32 and 81.

22.    **Claims 120-124 are rejected under 35 U.S.C. 103(a) as being unpatentable over Voltmann (U.S. Design Patent No. 264,810) in view of Karpf (U.S. Pub No. 2005/0165626).**

**Regarding claims 120-124**, Voltmann doesn't teach the instructional material for medication as being delivered by computer readable code. Karpf teaches medical instructions as being delivered through email (Abstract, Paragraph 0205). It would have been obvious to one having ordinary skill in the art at the time the invention was made

to send instructions for medicine over email as well as printing them on the container.

This would give the user more opportunities to read the instructions.

### *Conclusion*

23.    The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

The following references are cited to further show the state of the art with respect

to verification of comprehension of information:

> U.S. Patent No. 6,764,395 to DeLuca
>
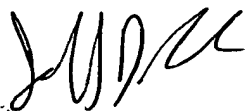> U.S. Patent No. 5,870,030 to Guyett
>
> U.S. Patent No. 6,456,981 to Dejaeger

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Michael Bekerman whose telephone number is (571)

272-3256.  The examiner can normally be reached on Monday - Friday, 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Eric W. Stamber can be reached on (571) 272-6724.  The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system.  Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).


MB

JEFFREY D. CARLSON
PRIMARY EXAMINER